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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/644,500
Filing Date: August 20, 2003
Appellant(s): TERRELL, ROSS C.

Martin Linihan
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 30, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-13 and 18-24.

Claims 14-17 and 25-42 have been canceled.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is deficient because appellants make reference to a variety of features not required by the claims. Claim 4 is representative of the claimed invention. Claim 4 merely provides

A method for the preparation of sevoflurane which comprises:

(a) providing a liquid mixture of $(CF_3)_2CHOCH_2Cl$, hydrogen fluoride, and an amine; and

(b) reacting the mixture; to form $(CF_3)_2CHOCH_2F$.

(6) Issues

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Additional issue is present as to whether claims 1-13 and 18-24 are properly rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of USP 5,969,193.

(7) Grouping of Claims

The rejection of claims 1-13 and 18-24 under 35 U.S.C. 103(a) as being unpatentable over Muffler (DE 2823969) in view of Regan (USP 3683092) stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 1-13 and 18-24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of USP 5969193 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 3,683,092	REGAN	8-1972
US 5,969,193	TERRELL	10-1999
DE 2,823,969	MUFFLER	12-1979

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-13 and 18-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Muffler (DE 2823969) in view of Regan (USP 3683092). Muffler

teaches the instant process except for the specific reactants claimed. It is noted that Muffler makes reference to hydrofluorides of nitrogen bases which differs from the claims reciting a mixture containing hydrogen fluoride and an amine. However, the reference indicates that the hydrofluorides can be generated *in situ* from the hydrogen fluoride and the amine, note the top of page 9 of the translation provided by applicants in the parent application[1]. Muffler does not teach some of the instant starting materials (and the corresponding final products). Such reactants differ only as to substituents that are removed from the reaction site and do not enter into the reaction. One would not expect the different substituents to affect the outcome of the reaction. One would be motivated to use the instant reactants in the prior art process since one would readily recognize the reactants necessary to afford the final products having the desired structure. Nothing patentable is seen in the use of a new starting material in an otherwise old process. Moreover, Regan clearly teaches that the instant reactants are known to react with fluorination agents to afford the same products. It would be readily apparent to one that the instant starting material could be used in the Muffler process to afford the instant products. Moreover, it is considered that the prior art provides further motivation to modify the prior art. Particularly note pages 4 and 5 of the translation provided in the parent application, where the advantages over other process are pointed out. One would be motivated to use the Muffler process in order to realize the advantages suggested in the reference.

[1] A copy thereof is attached for the Board's convenience.

The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). It is noted that, except for the claims that require the preparation of the $(CF_3)_2CHOCH_2Cl$, the claimed process differs from the Muffler process only as to the reactant (and corresponding product) used. Muffler standing alone would render the use of the reactant obvious since the claimed reactant is quite similar to the reactants used in the prior art. As for combining the references, as pointed out above, Muffler teaches a number of advantages in the process over other known fluorination process. One would be motivated to use the Muffler process in order to realize the advantages suggested in the reference.

Electronic and steric factors of the fluorinated methyl groups would not have been expected to affect the out come of the reaction. First, the reaction takes place at the chloro group which is removed from the fluorinated methyl groups of the $(CF_3)_2CHOCH_2Cl$ reactant. One would not expect the electronic and steric factors of the fluorinated methyl groups so removed to greatly influence the outcome of the reaction. Second, Muffler teaches the use of reactants, such as, $(CF_3)ClCHOCH_2Cl$ and 2-fluoro-2-chlorocyclopropyl chloromethyl ether, which also possess electronic and steric factors, afford the products one would expect.

Assertions that it is unpredictable whether the process would have work based on the statement in Regan that antimony fluorides did not give the desired product is not found persuasive of patentability. The fact that a different reagent behaved in an unexpected manner does not show that one would expect the Muffler fluorination agents not to be suitable. In fact applicants obtain the product one would predict from the teaching of Muffler.

Double Patenting

Claims 1-13 and 18-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of USP 5,969,193 Although the conflicting claims are not identical, they are not patentably distinct from each other because the conflicting claims are clearly within the purview of the instant broader generic claims. The conflicting claims of the patent differ from the instant claims by reciting the presence of water. The instant claims are open to the presence of water and such is clearly intended to be within the purview of the instantly claimed invention as set forth in the specification.

(11) Response to Argument

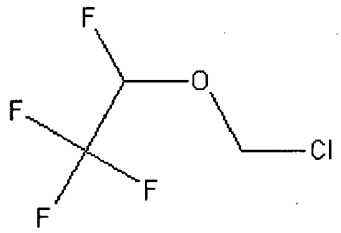
Claim Rejections - 35 USC § 103

Starting on page 5 of their brief appellants refer to USP 4,874,901 and presents experimental examples in the brief. Both are not properly or timely presented. See 37 CFR §§ 1.132, 1.116 and 41.33. USP 4,874,901 was never presented before Final

Action as evidence. The examples set forth in the brief itself were not presented before Final action are not in proper affidavit form. Accordingly, the evidence is not properly presented in a timely manner. As such, the evidence is not properly before the examiner nor the Board and has not been considered. Appellant's arguments based thereon are not considered to be substantiated.

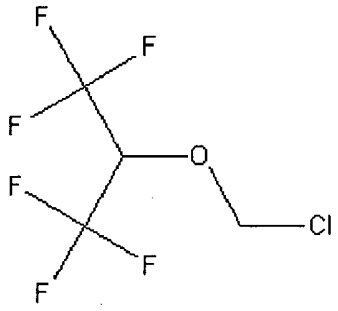
Appellant's argument that the combination of references only amounts to obvious to try is not seen. The Muffler reference discloses reactants that structurally very similar to the instant reactant regardless of whether one looks at a two dimensional or a three dimensional image.

Reactant of Example 5 of Muffler



and a chloro analogue in Example 9.

Appellant's Reactant



It is considered that, contrary to the assertions by appellants, one would expect that instant reactant to be suitable in the Muffler process as pointed out in the rejection above. One be motivated to use this particular reactant since it is a well known starting material in the preparation of sevoflurane [$(CF_3)_2CHOCH_2F$] as set forth in the rejection above.

Double Patenting

Appellants request to remove the issue by agreeing to file a terminal disclaimer on the condition the Board find the claims to be allowable[2].

It is considered that appellants have acquiesced in the instant rejection. Appellant's conditional willingness to file a terminal disclaimed in not seen to address the issue in a timely manner. No reason is seen why a terminal disclaimer could not have been filed before the filing of appellant's brief.

For the above reasons, it is believed that the rejections should be sustained.

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[2] It is unclear how appellant expect the claims to be found allowable if the claims are rejected for obvious type double patenting in the absence of a proper timely filed terminal disclaimer.

Respectfully submitted,

MICHAEL L. SHIPPEN
Primary Examiner
Art Unit 1621

October 17, 2004

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ATTACHMENT : TRANSLATION OF MUFFLER